

ESTTA Tracking number: **ESTTA601206**

Filing date: **04/29/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215536
Party	Defendant Volvo Construction Equipment North America, LLCca, LLC
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Attachments	answer.pdf(20046 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the Matter of Application Serial No. 85/859,210  
Published for Opposition on February 18, 2014  
Mark: SMART WORKS**

<b>MSC SERVICES CORP.; SID TOOL CO., INC.,)</b>	)	
<b>(d/b/a MSC INDUSTRIAL SUPPLY CO.</b>	)	
<b>Opposer,</b>	)	
	)	
<b>v.</b>	)	<b>Opposition No. 91215536</b>
	)	
<b>VOLVO CONSTRUCTION EQUIPMENT</b>	)	
<b>NORTH AMERICA, LLC</b>	)	
<b>Applicant.</b>	)	

**ANSWER**

Applicant Volvo Construction Equipment North America, LLC (“Applicant”), hereby responds to the Notice of Opposition filed by Opposers MSC Services Corp. (“MSC”) and Sid Tool Co., Inc. (“Sid Tool”) (collectively “Opposers”) as follows, stating that all allegations not specifically admitted are denied:

In answering the Notice of Opposition preamble, Applicant is without sufficient information to form a belief as to the truth of the allegations related to Opposers’ states of organization and places of business and on that basis denies the same. Applicant specifically denies that Opposers will be damaged by registration of Applicant’s SMART WORKS trademark (“Applicant’s Mark”). Applicant admits that Applicant filed Trademark Application Serial No. 85/859,210 for Applicant’s Mark on February 25, 2013 and that Applicant’s Mark was published for Opposition on February 18, 2014 for the goods stated in Opposers’ Notice of Opposition. Applicant admits that Applicant’s

application claims a date of first use of February 1, 2013. To the extent there are any remaining allegations in the preamble, they are denied.

1. Applicant is without sufficient information to form a belief as to the truth of the allegations in Paragraph 1 and on that basis denies the same.

2. Applicant is without sufficient information to form a belief as to the truth of the allegations in Paragraph 2 and on that basis denies the same.

3. Applicant is without sufficient information to form a belief as to the truth of the allegations in Paragraph 3 and on that basis denies the same.

4. Answering the allegations set forth in Paragraph 4, Applicant admits that records at the United States Patent and Trademark Office (“Trademark Office”) show that on March 25, 2010, Opposer MSC filed Trademark Application Serial No. 77/968,707 (“the ‘707 application”) for the goods and services and in the classes listed in Paragraph 4, and that the Trademark Office published the ‘707 application for opposition on January 11, 2011. However, Applicant denies the allegations in Paragraph 4 to the extent they imply that such trademark application is valid and pending with the Trademark Office or relevant to this proceeding. The ‘707 application was abandoned on or about March 11, 2014 for failure to provide a statement of use within the relevant time period. Opposer MSC filed an untimely statement of use with the Trademark Office on or about March 11, 2014 that specifically indicated that Opposer was not using in commerce, and thus permanently deleting from its application, the following goods and services: Non-metal belts, webbings, lifting bands, nets, raising bands as well as parts thereof sold as a unit with the goods; bands made of canvas for lifting and securing loads. Therefore, as of March 20, 2014, the filing date of the Notice of Opposition in this proceeding, Opposer

could not make a good faith allegation that it was the owner of an application for all the goods and services listed in Paragraph 4. Applicant is without sufficient information to form a belief as to the truth of the allegation that Opposer Sid Tool is a licensee of the ‘707 application and on that basis denies the same. To the extent there are any remaining allegations in Paragraph 4, they are denied.

5. Answering the allegations set forth in Paragraph 5, Applicant admits that records at the Trademark Office show that on March 25, 2010, Opposer MSC filed Trademark Application Serial No. 77/968,529 (“the ‘529 application”) for the goods and services and in the classes listed in Paragraph 5, and that the Trademark Office published the ‘529 application on January 11, 2011. However, Applicant denies the allegations in Paragraph 5 to the extent they imply that such trademark application is valid and pending with the Trademark Office or relevant to this proceeding. The ‘529 application was abandoned on or about April 14, 2014 for failure to timely submit a statement of use. Applicant is without sufficient information to form a belief as to the truth of the allegation that Opposer Sid Tool is a licensee of the ‘529 application and on that basis denies the same. To the extent there are any remaining allegations in Paragraph 5, they are denied.

6. Answering the allegations set forth in Paragraph 6, Applicant admits that records at the Trademark Office show that on March 25, 2010, Opposer MSC filed Trademark Application Serial No. 77/968,650 (“the ‘650 application”) for the goods and services and in the classes listed in Paragraph 6, and that the Trademark Office published the ‘650 application for opposition on January 4, 2011. Applicant is without sufficient information to form a belief as to the truth of the allegation that Opposer Sid Tool is a

licensee of the '650 application and on that basis denies the same. To the extent there are any remaining allegations in Paragraph 6, they are denied.

7. Answering the allegations set forth in Paragraph 7, Applicant admits that records at the Trademark Office show that on March 25, 2010, Opposer MSC filed Trademark Application Serial No. 77/968,461 ("the '461 application") for the goods and services and in the classes listed in Paragraph 7. Applicant is without sufficient information to form a belief as to the truth of the allegation that Opposer Sid Tool is a licensee of the '461 application and on that basis denies the same. To the extent there are any remaining allegations in Paragraph 7, they are denied.

8. Answering the allegations set forth in Paragraph 8, Applicant admits that records at the Trademark Office show that on March 25, 2011, Opposer MSC filed Trademark Application Serial No. 77/968,369 ("the '369 application") for the goods and service and in the classes listed in Paragraph 8. Applicant is without sufficient information to form a belief as to the truth of the allegation that Opposer Sid Tool is a licensee of the '369 application and on that basis denies the same. To the extent there are any remaining allegations in Paragraph 8, they are denied.

9. Answering the allegations set forth in Paragraph 9, Applicant admits that Opposer MSC filed Trademark Application Serial No. 85/448,652 ("the '652 application") for the goods and services and in the classes listed in Paragraph 9. Applicant is without sufficient information to form a belief as to the truth of the allegation that Opposer Sid Tool is a licensee of the '652 application and on that basis denies the same. To extent there are any remaining allegations in Paragraph 9, they are denied.

10. Applicant denies the allegations of Paragraph 10 as Applicant is not a corporation. Applicant is a limited liability company organized under the laws of Delaware, with a principal place of business located 312 Volvo Way, Shippensburg, Pennsylvania 17257.

11. Applicant denies the allegations of Paragraph 11.

12. Answering the allegations set forth in Paragraph 12, Applicant is without sufficient information to form a belief as to the truth of the allegations related to Opposers' alleged use of the mark WORKSMART in connection with marketing, distributing and selling any products or services, and therefore denies the same. To the extent Paragraph 12 can be construed as referring to the goods listed in Opposer MSC's several trademark applications, the '707, '529, '650, '461, '369, and '652 applications, Applicant denies that the goods listed in these applications are substantially similar or related to the goods listed in Applicant's application for Applicant's Mark. Accordingly, Applicant denies all the allegations contained in Paragraph 12.

13. Answering the allegations set forth in Paragraph 13, Applicant is without sufficient information to form a belief as to the truth of the allegations regarding whether Opposers have used the WORKSMART mark before Applicant's claimed date of first use of Applicant's Mark and therefore denies the same. Further, Applicant denies that Opposers have priority or superior rights in the marks WORKSMART and SMART WORKS vis-à-vis Applicant. Accordingly, Applicant denies all the allegations contained in Paragraph 13.

14. Applicant denies the allegations contained in Paragraph 14.

15. Applicant denies the allegations contained in Paragraph 15.

### **AFFIRMATIVE DEFENSES**

1. Opposers have failed to state a claim upon which relief may be granted.
2. Opposers will sustain no damage, injury, or prejudice as a result of the registration of Applicant's Mark.
3. Applicant's Mark is not confusingly similar to Opposers' mark because, among other things, Applicant's Mark differs from Opposers' mark in appearance and commercial impression.
4. Applicant's goods used in conjunction with Applicant's Mark are not substantially similar or related to Opposer's goods allegedly used in conjunction with Opposer's mark.
5. Applicant's goods used in conjunction with Applicant's Mark travel through different channels than Opposer's goods allegedly used in conjunction with Opposer's mark.
6. Opposer Sid Tool lacks standing.
7. Applicant has been using Applicant's Mark for over year without any actual confusion.
8. Applicant reserves the right to assert additional defenses as may be warranted by future discovery or investigation in this opposition.

WHEREFORE, Applicant requests that judgment be entered in its favor, that Opposers' Notice of Opposition be dismissed with prejudice, and that Applicant's Mark be registered.

This 29th day of April, 2014.

Respectfully submitted,

/Jacob S. Wharton/

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**CERTIFICATE OF MAILING**

I hereby certify that on April 29, 2014, I filed via electronic means (ESTTA) this ANSWER with the:

U. S. Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

/Victoria Thomas Sharpe/  
Victoria Thomas Sharpe

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing ANSWER has been served on Opposer's counsel by mailing said copy on April 29, 2014, via First Class Mail, postage prepaid to:

Michael R. Graif, Esq.  
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